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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,358	02/20/2004	Richard Carey	STNL 2656002	2399
21909 CARR LLP 670 FOUNDERS SQUARE 900 JACKSON STREET DALLAS, TX 75202	7590 03/13/2009		<div>EXAMINER</div> <div>SKINNER, SHEWANA D</div>	
			<div>ART UNIT</div> <div>3689</div>	<div>PAPER NUMBER</div>
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/783,358

**Applicant(s)**

CAREY, RICHARD

**Examiner**

SHEWANA SKINNER

**Art Unit**

3689

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 2/20/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) \_\_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/55/08)
- Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This communication is a First Action Non-Final on the merits. **Claims 1-16**, as originally filed, are currently pending and have been considered below.

#### ***Claim Objections***

1. **Claim 4** objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The steps in Claim 4 are already recited in Claim 1 therefore Claim 4 as recited is not further limiting.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. **Claims 5-8** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The code that is being used to perform the steps is not defined. It is generic and non-descript.
2. **Claims 9-12** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant

art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The code that is being used to perform the steps is not defined. It is generic and non-descript.

3. **Claim 13-16** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not disclose the structural means for performing the steps. The code referenced is software which is neither structural nor statutory, and it is generic and non-descript.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. **Claim 1** is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are in the determining if suitable unused parts exist, there is a step reciting what to do if no suitable part exists, however no step in reciting what do to if there are suitable parts that exist.

5. **Claims 5-12** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The word “code” lacks a clear and precise definition within the specification. The language of the claim, considered as a whole in light of the specification and given its broadest

reasonable interpretation is such that a person of ordinary skill in the art would read it with more than one reasonable interpretation and is therefore indefinite.

6. **Claims 13-16** are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: **Claims 13-16** recite an apparatus, with means for language that invokes U.S.C. 112, 6th ¶ that has no structural recitation within the specification to perform the recited functions.

***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. **Claims 1-4** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The machine-or-transformation test is a two-branched inquiry; an applicant may show that a process claim is statutory either by showing that his claim is tied to a particular machine, or by showing that his claims transforms an article to a different state or thing. Certain considerations are applicable to analysis under either branch. First, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility. Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity.

The claims as recited are not tied to a particular machine and do not transform the numerical data inputted into a different state or thing. Therefore, the claims do not recite statutory subject matter.

1. **Claims 1-4** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

MPEP 2105 states that: If the broadest reasonable interpretation of the claimed invention as a whole encompasses a human being, then a rejection under 35 U.S.C. 101 must be made indicating that the claimed invention is directed to nonstatutory subject matter. Claim 1-4 do not recite a particular machine and each step can reasonably be performed by a human. Therefore, as written, the claims can be interpreted to be claiming a human being, which is not statutory subject matter.

1. **Claims 13-16** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. An “apparatus” defined merely by software or terms synonymous with software is not deemed statutory. The apparatus as recited does not have any structural definition within claims and the specification does not disclose any structure relationship to said apparatus. Without the structure, the apparatus does not fit within the four statutory classes of method, apparatus, an article of manufacture and composition of matter.

#### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1, 3 and 4** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Jensen* (US 2001/0032111), hereinafter “*Jensen*”, in view of, *Lilly* (US 6,088,626), hereinafter “*Lilly*”, in further view of, *Suto* (US 2003/0214069), hereinafter, “*Suto*”.

**Referring to Claim 1:** *Jensen* discloses a method for custom manufacturing a tangible device (*Jensen*, abstract and [17 and 30] where the stone is a tangible device), comprising: receiving an order (*Jensen* [18]), wherein the order at least comprises one drawing (*Jensen* [44] where the drawing can be an attribute of purchased product), and wherein the at least one drawing at least comprises at least one part of a plurality of parts that comprise a unit (*Examiner finds the make-up of the drawing to be nonfunctional descriptive material not functionally involved in the steps recited. The step of receiving an order would be performed the same regardless of whether there is a drawing or what is on the drawing. It is also well known that a product ordered can be made of multiple parts. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404, (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994);* storing the order (*Jensen* [25]); referencing the at least one first part to a database of units and parts (*Jensen* [26]), if no mold exists in the inventory of molds, then manufacturing or buying a mold for the at least one first part (*Jensen* [23] where the materials could reasonably be a mold); determining if a suitable unused part of a plurality of unused parts exists within an inventory of unused parts by an associated part identifier (*Jensen* [26] components or raw materials on-site).

However, although it is well known in the art to use part identifiers to locate parts, *Jensen* does not explicitly disclose this step and although it discloses making a device with multiple layers, it does not explicitly disclose the use of a mold.

*Lilly* discloses a computerized system provided for scheduling a plurality of work orders wherein the least one first part number is associated with the at least one first part (*Lilly col 4 lines 6-11 where a part is material identified by a part number*); wherein each unused part of the plurality unused parts have part identifiers associated therewith (*Lilly col 4 lines 6-11 where a part is material identified by a part number*), if no suitable part exists in the inventory of unused parts, then determining if a mold for the at least one part exists in an inventory of molds (*Lilly col 5 lines 41-52 where the mold is a resource per col 4 lines 12-15*) and if a mold exists in the inventory of molds, then determining if the mold is available (*Lilly col 5 lines 41-52 where the mold is a resource per col 4 lines 12-15*) and retrieving the mold, once available (*Lilly col 5 lines 41-52 where the mold is a resource per col 4 lines 12-15*).

*Suto* discloses an automated process of creating a custom made part, that teaches casting the at least one first part with the mold that has been retrieved (*Suto [41]*).

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to use a part number and a mold as a tool as taught by *Lilly* and to cast the mold as taught by *Suto* in combination with the method of *Jenson*, in order to more effectively facilitate and at least partially automate the process of selection, identification, design and manufacturing of custom decorative stonework products.



**Referring to Claim 3.** *Jensen and Lilly* disclose a method wherein the step of determining if the mold is available as in Claim 1 and *Lilly* discloses retrieving a schedule of use for the mold (*Lilly col 5 lines 41-52 where the mold is a resource per col 4 lines 12-15*) and determining periods of time when the mold is in use for other projects (*Lilly col 5 lines 41-52*).

**Referring to Claim 4.** *Jensen and Lilly* disclose a method per Claim 1 and if the mold is not available, determining if the mold exists in a mold inventory (*Lilly col 5 lines 41-52*); and if the mold does not exist in a mold inventory, manufacturing or buying the mold (*Jensen [23] where the materials could reasonably be a mold*).

3. **Claim 2** is rejected under 35 U.S.C. 103(a) as being unpatentable over *Jensen* in view of Claim 1, in further view of *Kirkevoid (US 6,263,322)*, hereinafter “*Kirkevoid*”.

**Referring to Claim 2.** *Jensen, Lilly and Suto* disclose, wherein the step of determining if a suitable unused part of the plurality of unused parts exists within the inventory of unused parts as in Claim 1 and *Jensen* discloses determining if the suitable unused part has correct dimensions (*Jensen [26] where the computer notes the needed size and shape of the device*); and if the suitable unused part is too large, then cutting the suitable unused part to the correct dimensions (*Jensen [31]*).

However, they not explicitly disclose the step of searching part identifiers associated with each of the unused parts to find the part that matches that part identifier

*Kirkevoid* discloses searching part identifiers associated with each of the unused parts of the plurality of unused parts for a part identifier that at least matches the at least one first part

identifier associated with the at least one first part to determine if the suitable part identifier exists within the inventory of unused parts (*col 6 lines 45-57*).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to associate a part identifier with a part and use that as a method of searching as taught in *Kirkevoid*, in order to effectively ascertain if the needed part was available.

4. **Claims 5, 7 and 8** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Jensen* in view of *Lilly* in further view of *Suto*.

**Referring to Claim 5.** *Jensen* discloses a computer program product for custom manufacturing tangible devices the computer program product having a medium with a computer program embodied thereon (*Jensen [18 and 25] where there is a system that utilizes a computer to communicate the processes where the code is inherently embedded within the computer*), the computer program comprising: computer code for receiving an order (*Jensen [19] where Examiner finds the type of content of the order to be nonfunctional descriptive material not functionally involved in the code recited. The code needed to perform the step would be performed the same regardless of the content of the order. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404, (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994)*), wherein the order at least comprises one drawing, and wherein the at least one drawing at least comprises at least one part of a plurality of parts that comprise a unit; computer code for storing the order [*Jensen 25*]; computer code for referencing the at least one first part to a database of units and parts [*Jensen 25 and 26*], wherein the least

one first part number is associated with the at least one first part (*Lilly abstract define the art as a computerized system that inherently utilizes code and col 4 lines 6-11 where a part is material identified by a part number*); wherein each unused part of the plurality unused parts have part identifiers associated therewith (*Examiner finds the associated identifiers to be nonfunctional descriptive material not functionally involved in the steps recited. The code for referencing would be performed the same regardless of the type of identifier. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404, (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994)*); if no suitable part exists in the inventory of unused parts, then if no mold exists in the inventory of molds, then computer code for manufacturing or computer code for buying a mold for the at least one first part (*Jensen [23] where the materials could reasonably be a mold*);

computer code for determining if a suitable unused part of a plurality of unused parts exists within an inventory of unused parts by an associated part identifier (*Lilly col 4 lines 6-11 where a part is material identified by a part number*),

However, although it is well known in the art to use part identifiers to locate parts, *Jensen* does not explicitly disclose the code to perform this step and although it discloses making a device with multiple layers, it does not explicitly disclose the code to use a mold.

*Lilly* discloses a computerized system that inherently operates using code computer code where the code determines if a mold for the at least one part exists in an inventory of molds (*Lilly col 5 lines 41-52 where the mold is a resource per col 4 lines 12-15*); if a mold exists in

the inventory of molds, then computer code for determining if the mold is available (*Lilly col 5 lines 41-52 where the mold is a resource per col 4 lines 12-15*); and computer code for retrieving the mold, once available (*Lilly col 5 lines 41-52 where the mold is a resource per col 4 lines 12-15*), manufactured, or bought.

*Suto* discloses an automated process of creating a block, which is a tangible device, that discloses casting the at least one first part with the mold that has been retrieved (*Suto where the automation inherently has code [41]*).

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to use a part number and a mold as a tool as taught by *Lilly* and to cast the mold as taught by *Suto* in combination with the method of *Jensen*, in order to more effectively facilitate and at least partially automate the process of selection, identification, design and manufacturing of custom decorative stonework products.

**Referring to Claim 7.** *Jensen and Lilly* disclose a computer program product comprised of code wherein determining if the mold is available as in Claim 5 and *Lilly* further discloses code that retrieves a schedule of use for the mold (*Lilly col 5 lines 41-52 where the mold is a resource per col 4 lines 12-15*) and determining periods of time when the mold is in use for other projects (*Lilly col 5 lines 41-52*).

**Referring to Claim 8.** *Jensen and Lilly* disclose a computer code per Claim 5 and if the mold is not available, determining if the mold exists in a mold inventory (*Lilly col 5 lines 41-52*); and if the mold does not exist in a mold inventory, manufacturing or buying the mold (*Jensen [23] where the materials could reasonably be a mold*).

5. **Claim 6** is rejected under 35 U.S.C. 103(a) as being unpatentable over *Jensen* in view of Claim 5, in further view of *Kirkevold*.

**Referring to Claim 6.** *Jensen*, *Lilly* and *Suto* disclose, wherein the computer code of determining if a suitable unused part of the plurality of unused parts exists within the inventory of unused parts as in Claim 5 and *Jensen* further discloses determining if the suitable unused part has correct dimensions (*Jensen [26] where the computer notes the needed size and shape of the device*); and if the suitable unused part is too large, then cutting the suitable unused part to the correct dimensions (*Jensen [31]*).

However, they not explicitly disclose the step of searching part identifiers associated with each of the unused parts.

*Kirkevold* discloses computer code is enabled to search part identifiers associated with each of the unused parts of the plurality of unused parts for a part identifier that at least matches the at least one first part identifier associated with the at least one first part to determine if the suitable part identifier exists within the inventory of unused parts (*col 6 lines 45-57*).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to associate a part identifier with a part and use that as a method of searching as taught in *Kirkevold*, in order to effectively ascertain if the needed part was available.

6. **Claims 9, 11 and 12** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Jensen* in view of *Lilly* in further view of *Suto*.

**Referring to Claim 9.** *Jensen* discloses a processor for custom manufacturing a tangible device, the computer program (*Jensen [18 and 25]* where there is a system that utilizes a computer to communicate the processes where the code is inherently embedded within the computer), the computer program comprising: computer code for receiving an order (*Jensen [19]* where Examiner finds the type of content of the order to be nonfunctional descriptive material not functionally involved in the code recited. The code needed to perform the step would be performed the same regardless of the content of the order. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404, (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994)), wherein the order at least comprises one drawing, and wherein the at least one drawing at least comprises at least one part of a plurality of parts that comprise a unit; computer code for storing the order [*Jensen 25*]; computer code for referencing the at least one first part to a database of units and parts [*Jensen 25 and 26*], wherein the least one first part number is associated with the at least one first part (*Lilly abstract define the art as a computerized system that inherently utilizes code and col 4 lines 6-11 where a part is material identified by a part number*); wherein each unused part of the plurality unused parts have part identifiers associated therewith (*Examiner finds the associated identifiers to be nonfunctional descriptive material not functionally involved in the steps recited. The code for referencing would be performed the same regardless of the type of identifier. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404, (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994)); if no suitable part exists in the inventory of unused parts,

then if no mold exists in the inventory of molds, then computer code for manufacturing or computer code for buying a mold for the at least one first part (*Jensen [23] where the materials could reasonably be a mold*);

However, although it is well known in the art to use part identifiers to locate parts, *Jensen* does not explicitly disclose the code to perform this step and although it discloses making a device with multiple layers, it does not explicitly disclose the code to use a mold.

*Lilly* discloses a computerized system that inherently operates using code computer code where the code determines if a mold for the at least one part exists in an inventory of molds (*Lilly col 5 lines 41-52 where the mold is a resource per col 4 lines 12-15*); if a mold exists in the inventory of molds, then computer code for determining if the mold is available (*Lilly col 5 lines 41-52 where the mold is a resource per col 4 lines 12-15*); and computer code for retrieving the mold, once available (*Lilly col 5 lines 41-52 where the mold is a resource per col 4 lines 12-15*), manufactured, or bought.

*Suto* discloses an automated process of creating a block, which is a tangible device, that discloses casting the at least one first part with the mold that has been retrieved (*Suto where the automation inherently has code [41]*).

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to use a part number and a mold as a tool as taught by *Lilly* and to cast the mold as taught by *Suto* in combination with the method of *Jenson*, in order to more effectively facilitate and at least partially automate the process of selection, identification, design and manufacturing of custom decorative stonework products.

**Referring to Claim 11.** *Jensen and Lilly* disclose a computer program product comprised of code wherein determining if the mold is available as in Claim 9 and *Lilly* further discloses code that retrieves a schedule of use for the mold (*Lilly col 5 lines 41-52 where the mold is a resource per col 4 lines 12-15*) and determining periods of time when the mold is in use for other projects (*Lilly col 5 lines 41-52*).

**Referring to Claim 12.** *Jensen and Lilly* disclose a computer code per Claim 9 and if the mold is not available, determining if the mold exists in a mold inventory (*Lilly col 5 lines 41-52*); and if the mold does not exist in a mold inventory, manufacturing or buying the mold (*Jensen [23] where the materials could reasonably be a mold*).

7. **Claim 10** is rejected under 35 U.S.C. 103(a) as being unpatentable over *Jensen* in view of Claim 9, in further view of *Kirkevoid*.

**Referring to Claim 10.** *Jensen, Lilly and Suto* disclose, wherein the computer code of determining if a suitable unused part of the plurality of unused parts exists within the inventory of unused parts as in Claim 9 and *Jensen* further discloses determining if the suitable unused part has correct dimensions (*Jensen [26] where the computer notes the needed size and shape of the device*); and if the suitable unused part is too large, then cutting the suitable unused part to the correct dimensions (*Jensen [31]*).

However, they not explicitly disclose the step of searching part identifiers associated with each of the unused parts.



*Kirkevold* discloses computer code is enabled to search part identifiers associated with each of the unused parts of the plurality of unused parts for a part identifier that at least matches the at least one first part identifier associated with the at least one first part to determine if the suitable part identifier exists within the inventory of unused parts (*col 6 lines 45-57*).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to associate a part identifier with a part and use that as a method of searching as taught in *Kirkevold*, in order to effectively ascertain if the needed part was available.

8. **Claims 13, 15 and 16** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Jensen* in view of *Lilly* in further view of *Suto*.

**Referring to Claim 13.** *Jensen* discloses an apparatus for custom manufacturing tangible devices (*Jensen abstract and [18 and 25]*) comprising: mean for receiving an order (*Jensen [19]* where Examiner finds the type of content of the order to be nonfunctional descriptive material not functionally involved in the code recited. The means needed to perform the step would be performed the same regardless of the content of the order. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404, (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994)), wherein the order at least comprises one drawing, and wherein the at least one drawing at least comprises at least one part of a plurality of parts that comprise a unit; computer code for storing the order [*Jensen 25*]; means for referencing the at least one first part to a database of units and parts [*Jensen 25 and 26*], wherein the least one first part number is associated with the at least one first part (*Lilly abstract define*

*the art as a computerized system that inherently utilizes code and col 4 lines 6-11 where a part is material identified by a part number); wherein each unused part of the plurality unused parts have part identifiers associated therewith (Examiner finds the associated identifiers to be nonfunctional descriptive material not functionally involved in the steps recited. The code for referencing would be performed the same regardless of the type of identifier. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404, (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994)); if no suitable part exists in the inventory of unused parts, then if no mold exists in the inventory of molds, then means for manufacturing or computer code for buying a mold for the at least one first part (Jensen [23] where the materials could reasonably be a mold);*

means for determining if a suitable unused part of a plurality of unused parts exists within an inventory of unused parts by an associated part identifier (*Lilly col 4 lines 6-11 where a part is material identified by a part number*),

However, although it is well known in the art to use part identifiers to locate parts, *Jensen* does not explicitly disclose the mean for performing this step and although it discloses making a device with multiple layers, it does not explicitly disclose the means for using a mold.

*Lilly* discloses an apparatus with a means for determining if a mold for the at least one part exists in an inventory of molds (*Lilly col 5 lines 41-52 where the mold is a resource per col 4 lines 12-15*); if a mold exists in the inventory of molds, then computer code for determining if the mold is available (*Lilly col 5 lines 41-52 where the mold is a resource per col 4 lines 12-15*);

and computer code for retrieving the mold, once available (*Lilly col 5 lines 41-52 where the mold is a resource per col 4 lines 12-15*), manufactured, or bought.

*Suto* discloses a means for creating a block, which is a tangible device, that discloses casting the at least one first part with the mold that has been retrieved (*Suto [41]*).

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to use a part number and a mold as a tool as taught by *Lilly* and to cast the mold as taught by *Suto* in combination with the method of *Jensen*, in order to more effectively facilitate and at least partially automate the process of selection, identification, design and manufacturing of custom decorative stonework products.

**Referring to Claim 15.** *Jensen and Lilly* disclose a means for determining if the mold is available as in Claim 13 and *Lilly* further discloses a means for retrieving a schedule of use for the mold (*Lilly col 5 lines 41-52 where the mold is a resource per col 4 lines 12-15*) and determining periods of time when the mold is in use for other projects (*Lilly col 5 lines 41-52*).

**Referring to Claim 16.** *Jensen and Lilly* discloses means for, per Claim 13, and if the mold is not available, determining if the mold exists in a mold inventory (*Lilly col 5 lines 41-52*); and if the mold does not exist in a mold inventory, manufacturing or buying the mold (*Jensen [23] where the materials could reasonably be a mold*).

9. **Claim 14** is rejected under 35 U.S.C. 103(a) as being unpatentable over *Jensen* in view of Claim 13, in further view of *Kirkevold*.

**Referring to Claim 14.** *Jensen, Lilly and Suto* disclose a means for determining if a suitable unused part of the plurality of unused parts exists within the inventory of unused parts as in Claim 13 and Jensen further discloses determining if the suitable unused part has correct dimensions (*Jenson [26] where the computer notes the needed size and shape of the device*); and if the suitable unused part is too large, then cutting the suitable unused part to the correct dimensions (*Jensen [31]*).

However, they not explicitly disclose the step of searching part identifiers associated with each of the unused parts.

*Kirkevold* discloses a means for searching part identifiers associated with each of the unused parts of the plurality of unused parts for a part identifier that at least matches the at least one first part identifier associated with the at least one first part to determine if the suitable part identifier exists within the inventory of unused parts (*col 6 lines 45-57*).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to associate a part identifier with a part and use that as a method of searching as taught in *Kirkevold*, in order to effectively ascertain if the needed part was available.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. *Lilly (US 6,801,820)*.

### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHEWANA SKINNER whose telephone number is (571)270-7141. The examiner can normally be reached on Monday-Friday 8:00am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mooneyham Janice can be reached on (571)272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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3/12/09